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REMARKS

This response is intended as a full and complete response to the final Office Action mailed May 19, 2005. In the Office Action, the Examiner notes that claims 8-21 are pending of which claims 8-21 stand rejected. By this response, claims 8-21 continue unamended.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant responsive amendments.

Rejections

35 U.S.C. §103

Claims 8-21

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Day et al. (U.S. Pat. 5,996,015, hereinafter "Day") in view of DeMoney (U.S. Patent 6,065,050, hereinafter "DeMoney") and Katinsky et al. (U.S. Pat. 6,452,609, hereinafter "Katinsky").

The Applicants respectfully disagree. According to the MPEP, all limitations must be taught or suggested by the references.

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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Also, prior art must suggest the desirability of the claimed invention.

2143.01 Suggestion or Motivation To Modify the References [R-2]

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

The present invention describes a method and apparatus for reducing latency caused by information server processing of subscriber requests wherein a plurality of content streams defined by a playlist, including fast-forward and reverse streams, are sequentially provided to a subscriber in a substantially seamless manner and wherein

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the playlist is updated and otherwise maintained in response to subscriber commands and requests. Applicants' independent claims 8 and 16 recite:

"8. In an information distribution system including provider equipment and subscriber equipment, said provider equipment communicating to said subscriber equipment information streams including content requested by said subscriber equipment, an apparatus comprising:

a session manager, for interacting with said subscriber equipment and maintaining a playlist, said playlist defining at least one content stream to be provided to said subscriber equipment, said playlist further identifying reverse and fast-forward streams associated with said at least one content stream, each content stream comprising a plurality of splicing entry and exit points dispersed therein to enable transitioning between content streams;

a server, for storing content streams; and

a server controller for retrieving from said server, content streams defined by said playlist, said content streams being sequentially provided to said subscriber equipment;

said session manager modifying said playlist in response to playlist modification commands received from said subscriber equipment, wherein a next stream in said playlist is spliced at an entry point associated with an exit point of a current stream being sent to said subscriber equipment."

"16. In an information distribution system including provider equipment and subscriber equipment, said provider equipment communicating content to said subscriber equipment via a distribution network, a provider method comprising the steps of:

establishing a session with a subscriber;

generating, at said provider equipment, a playlist for said subscriber if a playlist does not presently exist, said playlist determining a sequence of content streams to be retrieved from a server and coupled to a transport processor for distribution to said subscriber via said distribution network, each content stream comprising a plurality of splicing entry and exit points dispersed therein to enable transitioning between content streams, said playlist further identifying reverse and fast-forward streams associated with said content streams;

in the case of said subscriber transmitting a playlist modification command, modifying said playlist at said provider equipment in response to said playlist modification command;

in the case of said subscriber transmitting a content stream modification command, modifying said content stream in response to said content stream modification command;

determining a next content stream to be provided to said subscriber from said playlist;

closing a present content stream being retrieved from a sever and provided to said transport processor; and

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communicating said next content stream to be provided to said server to a server controller, said server controller responsively causing said next content stream to be provided to said transport processor upon the termination of the present content stream provided to said transport processor, wherein said next content stream in said playlist is spliced at an entry point associated with an exit point of a current stream being sent to said subscriber equipment."

The invention as claimed in claims 8 and 16 is directed towards maintaining a playlist having fast-forward and reverse streams associated with a content stream, wherein said next content stream in said playlist is spliced at an entry point associated with an exit point of a current stream being sent to the subscriber equipment. Claim 8 specifically claims "maintaining a playlist... said playlist further identifying reverse and fast-forward streams." Claim 16 specifically claims "generating... a playlist... said playlist further identifying reverse and fast-forward streams."

The Day reference is directed to provide a continuous data flow to enable a seamless and continuous presentation of the selected multimedia data files. Day is completely silent on maintaining/generating a playlist having fast-forward and reverse streams associated with a content stream. The nature of the problem Day is trying to solve is directed to a seamless and continuous presentation of the selected media file.

The DeMoney reference is directed toward efficient indexing between normal play and trick play and further directed for reducing the processing burden of the media server. It is completely silent on maintaining/generating a playlist having fast-forward and reverse streams associated with a content stream. A playlist of the present invention is "a list of contents requested by each subscriber" and "may comprise data identifying the title, storage location, and presentation time of one or more content streams such as movies, music and the like." (See page 6, lines 23-32). It is separate and distinct from the index or lookup table of DeMoney which is just a table of offset information. Moreover, DeMoney is not trying to solve any problems associated with the playlist having fast-forwarding and reversing content streams. It is directed to efficient indexing between normal play stream and trick play stream.

The Katinsky reference is directed towards a computer media player modifying a playlist for media objects. It is completely silent on maintaining/generating a playlist having fast-forward and reverse streams associated with a content stream. The nature

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of the problem Katinsky is trying to solve involves efficient modification of media objects in a playlist.

None of the references teach or suggest the desirability of maintaining a playlist having fast-forward and reverse streams associated with a content stream. As explained above, Day, DeMoney and Katinsky are all solving different problems as the present claimed invention and with each other. None of them disclose the claimed playlist having fast-forwarding and reversing content streams or is trying to solve any problems associated with such playlist. Therefore, there is no motivation to combine the references.

Even if one incorrectly concludes there is motivation to combine the references, and the Day, DeMoney and Katinsky references could somehow be operably combined, the combination would disclose providing a continuous data flow to enable a seamless and continuous presentation of the selected multimedia data files. When the user desires trick play, the system would employ efficient indexing between normal play and trick play. Efficient indexing as taught by the prior art does not include the modification of the playlist. Moreover, the prior art only teaches modifying a playlist for multimedia data files and not the trick plays. Nowhere in any of the references, either singularly or in combination, is there any teaching or suggestion of "playlist having fast-forwarding and reversing content streams." That is, Applicants' invention provides maintaining a playlist having fast-forward and reverse streams associated with a content stream which is not disclosed, taught or suggested by the references. There is no teaching or suggestion to place the trick play streams of DeMoney in the Playlist of Day or Katinsky. Therefore, the combined references fail to teach or suggest Applicants' invention as a whole.

As such, Applicants submit that independent claims 8 and 16 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 9-15 and 17-21 depend, either directly or indirectly, from independent claims 8 and 16 and recite additional features thereof. As such, and at least for the same reasons as discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

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CONCLUSION

Applicants believe all the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of an adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

7/18/05

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